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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Christoph E. Scheurich, et al. § Art Unit: 2613
Serial No.: 09/083,601 §
Filed: May 22, 1998 § Examiner: Shawn An
Title: Maintaining a Frame Rate in a § Docket No. INTL-0045-US
Digital Imaging System § (P5755)

Commissioner for Patents
Washington, D.C. 20231

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REPLY TO OFFICE ACTION DATED SEPTEMBER 11, 2001

Dear Sir:

In an Office Action mailed on September 11, 2001, claims 1, 3-5, 7, 9-11, 13, 15, 17-19 and 21-23 were rejected under 35 U.S.C. § 102(e) as being anticipated by Thro; and claims 2, 6, 8, 12, 14, 16, 20 and 24 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Thro. These rejections are discussed in the corresponding sections below.

§ 102 Rejections:

In the latest Office Action, the Examiner states that the determining act of claim 1 is taught by the language of Thro that discusses the determining a priority between a frame rate and a resolution for video frame. However, the Assignee requests the Examiner to read each claim in its entirety. For example, claim 1 recites "determining whether it is possible to transmit data at a requested resolution and a requested frame rate." However, simply selecting a priority between a frame rate and a resolution rate does not disclose determining whether it is possible to transmit data at a requested resolution and a requested frame rate. Thus, the Assignee requests withdrawal of the corresponding § 102 rejection of claim 1. Likewise, as pointed out in the last reply, Thro does not teach the limitations of claims 7, 13 and 19 and thus, withdrawal of these corresponding rejections is requested. For the same reasons, Thro does not teach or suggest the limitation of claim 19, and thus withdrawal of the § 102 rejection of claim 19 is requested.

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| Date of Deposit: <u>9-25-01</u> |
| I hereby certify under 37 CFR 1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated above and is addressed to the Commissioner for Patents, Washington, DC 20231. |
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| Debra Cutrona |

§ 103 Rejections:

The Examiner maintains the § 103 rejections based on the combination of Thro and the alleged general level of skill in the art. However, to establish a *prima facie* obviousness rejection, the Examiner must show some suggestion or motivation to modify Thro in the prescribed manner. M.P.E.P. § 2143. Because the Examiner has not made the showing, the Examiner has not established a *prima facie* case of obviousness. The Examiner also improperly relies on the alleged general level of skill in the art, as “rarely, however, will the skill in the art component operate to supply missing knowledge or prior art to reach an obviousness judgment.” *All-Site Corp. v. VSI Int'l, Inc.*, 50 U.S.P.Q.2d 1161, 1171 (Fed. Cir. 1999).

CONCLUSION

In view of the foregoing, the Assignee requests withdrawal of the §§ 102 and 103 rejections and a favorable action in the form of a Notice of Allowance. The Commissioner is authorized to pay any additional fees or credit any overpayment to Deposit Account No. 20-1504 (INTL-0045-US).

Date: 7/25/01

Respectfully submitted,

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